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TRANSMITTAL FORM

Application Number 09/427,699

Filing Date 27 October 1999

First Named Inventor Ming ZHAO

Group Art Unit 1632

Examiner Name S. L. Chen, Ph.D.

Attorney Docket No. 312762001800

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SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual Name Kate H. Murashige, Reg No. 29,959
Morrison & Foerster LLP
3811 Valley Centre Drive, Suite 500, San Diego, California 92130

Signature *Kate H. Murashige*

Date December 18, 2002

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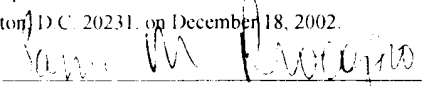
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PATENT
Docket No. 312762001800

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Ming ZHAO *et al.*

Serial No.: 09/427,699

Filing Date: 27 October 1999

For: TREATMENT OF ALOPECIA

Examiner: Shin-Lin Chen, Ph.D.

Group Art Unit: 1632

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AMENDMENT UNDER 37 C.F.R. §1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to an Office action herein mailed 18 September 2002 time for response which was set to expire 18 December 2002. The pending claims, claims 1-5 and were rejected under 35 U.S.C. § 102(e)(f) and/or (g) as anticipated by Lishko *et al.*, U.S. Patent No. 5,753,263. Reconsideration of this basis for rejection is respectfully requested.

As the Office correctly points out, the Lishko patent indeed discloses a method of preventing chemotherapy -induced alopecia by delivering an expression vector comprising a nucleic acid molecule coding for p21 entrapped in a liposomal composition. The inventorship set forth on this patent is Lishko and Lingna Li. The Office also correctly points out that one way to overcome the rejection under 35 U.S.C. § 102(e) is to show that the invention disclosed but not claimed in the '263 patent was derived from the inventor of the present application. Applicant believes that this

has already been done. Applicant's have already pointed out, for example, in their submission dated 6 March 2002 that the contribution of Valeryi Lishko, the listed inventor other than Lingna Li in the '263 did not involve p21. Therefore, that invention is solely the invention of Lingna Li, who is the sole inventor in the present application as further discussed below. There is nothing in the outstanding rejection under 35 U.S.C. § 102(e) that provides any basis for doubting this statement or questions the adequacy of that representation. As the present applicant has supplied sufficient reason to show that the invention disclosed but not claimed in the '263 patent was derived from the inventor herein, it appears this basis for rejection is overcome.

With respect to the rejection under 35 U.S.C. § 102(f) or (g) the Office questions whether Zhao and Saito can be removed as inventors under 37 C.F.R. § 1.48(b) because the declaration filed 2/1/00 indicated that they contributed to the inventions claimed. The Office is reminded that their petition under 37 C.F.R. § 1.48(a) to add Linga Li as an inventor was granted; the declaration filed along with that petition which supercedes the original declaration indicated that all of Li, Zhao and Saito contributed to the claims then pending. The claims then pending included claims 8-12 having to do with observing the expiration of p21 in hair follicle cells; it is to that claim that their contributions were made. As claims 8-12 to that aspect of the invention were cancelled, the invention to which Zhao and Saito contributed is no longer being claimed. Accordingly, it is appropriate to delete them as inventors under 37 C.F.R. § 1.48(b). The declaration accompanying the petition to add inventor Li confirms that Li, along with Saito and Zhao contributed to the invention then claimed. The declaration is not specific to claim 1.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

As it has been shown that Ligna Li is the sole inventor of the invention as now claimed as well as the disclosed but unclaimed invention in the '263 patent, it is believed that the rejections may be withdrawn and claims 1-5 and 7 passed to issue.

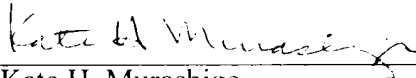
In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the

cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 312762001800. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: December 18, 2002

By:



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